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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/760,242	01/21/2004	Kia Silverbrook	WAL04US	1572
24011	7590	08/03/2005	EXAMINER	
SILVERBROOK RESEARCH PTY LTD 393 DARLING STREET BALMAIN, 2041 AUSTRALIA			COLILLA, DANIEL JAMES	
			ART UNIT	PAPER NUMBER
			2854	

DATE MAILED: 08/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/760,242

Applicant(s)

SILVERBROOK ET AL.

Examiner

Daniel J. Colilla

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 May 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 3-19 and 49 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 3-11, 13-19 and 49 is/are rejected.
- 7) ☒ Claim(s) 12 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Terminal Disclaimer***

1. The terminal disclaimer filed on 5/16/05 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of any patent granted from Application Number 10/760,214 has been reviewed and is accepted. The terminal disclaimer has been recorded.

### ***Claim Objections***

2. Claims 17-19 are objected to because of the following informalities: claims 17-18 depend from a cancelled claim (claim 2). For purposes of examination, these claims will be examined as if they depended from claim 49. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claim 49 is rejected under 35 U.S.C. 102(b) as being anticipated by Taylor et al. (US 5,593,035).

With respect to claim 49, Taylor et al. discloses a consumer tote including a disposable exterior 70 (note, while Taylor et al. is silent on the material of exterior 70, anything can be considered disposable because anything can be disposed of), a main access flap 74, and a pair of core access openings 100 and an interior in which is located

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a disposable core 18 (again, anything can be considered disposable) aligned with the access openings as shown in Figure 2 of Taylor et al. The access flap 74 is hinged at 86 as shown in Figure 3 of Taylor et al. for rotating between an open position (see Figure 3) and a closed position (see Figure 1). In the closed position the flap 74 restricts access to a gap 106 (see Figure 1) formed between flap 74 and an adjacent edge 104 of the exterior.

5. Claims 49, 4, 5, 8, and 18-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Harris et al. (US 5,161,685).

With respect to claim 49, Harris et al. discloses a consumer tote including a disposable exterior 42 (note, while Harris et al. is silent on the material of exterior, anything can be considered disposable because anything can be disposed of), a main access flap 46, and a pair of core access openings 44b,46b and an interior in which is located a disposable core c (again, anything can be considered disposable) aligned with the access openings as shown in Figure 5 of Harris et al. The access flap 46 is hinged for rotating between an open position (see Figure 5) and a closed position (Harris et al., col. 5, lines 8-13). In the closed position the flap 46 restricts access to a gap formed between flap 46 and an adjacent edge 44c of the exterior (Harris et al., col. 5, lines 23-26).

With respect to claims 4 and 18, Harris et al. discloses molded hubs 48 for supporting the core c as shown in Figure 5 of Harris et al.

With respect to claims 5 and 19, Figure 5 of Harris et al. shows that the openings 44b,46b are comprised of bearing surfaces (Harris et al., col. 5, lines 13-19).

With respect to claim 8, Harris et al. discloses an external coupling 50 that could be used to engage a rotating winding spindle.

*Claim Rejections - 35 USC § 103*

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Taylor et al. (US 5,593,035) as applied to claim 49 above, and further in view of Crim (US 4,467,974).

Taylor et al. discloses the claimed tote except that he is silent on the material that it is made of. However, Crim discloses holder for a roll of paper that can be made of plastic, wood, fiberglass or any other suitable material having sufficient strength (Crim, col. 2, lines 35-41). These materials are all non-metallic and at least plastic and fiberglass can be considered textiles.

8. Claims 5-7 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Harris et al. (US 5,161,685), as applied to claims 49, 4 and 18 above, and further in view of Sirianni (US 5,413,220).

With respect to claims 5-6 and 19, Harris et al. discloses the claimed consumer tote except for each hub being surrounded by a bearing surface which locates the hub in a respective access opening. However, Sirianni teaches a supporting hub for a core C which has a surface that surrounds the hub and bears on the bottom of the interior of box B as shown in Figure 8 of Sirianni. In combination with Harris et al. the bearing surface

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taught by Sirianni would provide the support that locates the hubs in the access openings disclosed by Harris et al.. It would have been obvious to combine the teaching of Sirianni with the consumer tote disclosed by Harris et al. for the advantage of the energy attenuating support which protects the roll in the box from damage due to shock (Sirianni, col. 1, lines 6-12).

With respect to claim 7, the bearing surface taught by Sirianni is circular and is connected to the hub by spokes 44 as shown in Figure 2 of Sirianni.

9. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Harris et al. (US 5,161,685), as applied to claims 49, 4 and 8 above, and further in view of Kofler (US 4,697,756).

Harris et al. discloses the claimed tote except for the ring of teeth on the external coupling. However, Kofler discloses a coupling 26a for driving a hub that includes a ring of teeth as shown in Figure 1 of Kofler. It would have been obvious to combine the teaching of Kofler with the tote disclosed by Harris et al. for the advantage of providing a positive mechanical engagement in the coupling that prevents slipping of the coupling.

10. Claims 10-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Harris et al. (US 5,161,685), as applied to claim 49 above, and further in view of Jamet (EP 826618).

With respect to claim 10, Harris et al. discloses the claimed tote except for the handle that folds flat against the exterior. Harris et al. discloses a handle 121, but it does not fold flat. However, Jamet discloses a tote 4 with a handle 11,11 that folds flat against

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the exterior of the tote as shown in Figure 1 of Jamet and disclosed in the English abstract. It would have been obvious to combine the teaching of Jamet with the tote disclosed by Harris et al. for the advantage of a handle that can be folded out of the way when not in use to allow for easier storage or insertion of the tote into other devices.

With respect to claim 11, the handle is formed by two similar sub-units 11 which fold from a flat position adjacent the sides of the tote to a cooperating position in which a handle opening in each sub-unit 11 to form a grip as shown in Figure 1 of Jamet.

11. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Harris et al. (US 5,161,685), as applied to claim 49 above, and further in view of Cocchi et al. (US 5,450,949).

Harris et al. in discloses the claimed tote except for the visible marker. However, Cocchi et al. teaches a roll of media that has a label 6 with a visible indicator 8 indicating proper placement of the reel relative to unwinding means. It would have been obvious to combine the teaching of Cocchi et al. with the tote disclosed by Harris et al. for the advantage of indicating to the user the proper orientation of the tote relative to an unwinding means. Furthermore, such a visible indicator is a basic instructional expedient that would have been obvious to one of ordinary skill in the art.

12. Claims 14 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Harris et al. (US 5,161,685).

With respect to claim 14, Harris et al. discloses the claimed tote except that no specific dimension is disclosed. However, the dimensioning of a product to fit another

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apparatus would have been an obvious modification that could have readily been determined through routine experimentation by one of ordinary skill in the art.

Additionally, it has been established that when the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device (see MPEP 2144.04, section IV, part A).

With respect to claim 16, while it is not known to the examiner if the tote disclosed by Harris et al. can hold 50 meters of wallpaper, if it cannot, then it is simply a matter of making the tote larger. Changes in dimension of the tote have been addressed above with respect to claim 14.

13. Claims 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Harris et al. (US 5,161,685) in view of Takayama (US 6,520,395).

Harris et al. discloses the claimed tote except for the viewing window. However, Takayama discloses a tote 1 for containing a roll of media including a window (not shown) in the side sheet 4 or the lid 7 (Takayama, col. 9, lines 28-30). It would have been obvious to combine the teaching of Takayama with the tote disclosed by Harris et al. for the advantage of being able to view the inside of the tote to determine what type of media is inside or how much media is remaining.

14. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Harris et al. (US 5,161,685) in view of Moggia (EP 327712).



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Harris et al. discloses the claimed tote except for the adjacent edge of the exterior that includes a return lip. However, Moggia discloses an exterior edge, adjacent the gap, that includes a return lip 9 as shown below in Figures 1 and 4 of Moggia. It would have been obvious to combine the teaching of Moggia with the tote disclosed by Harris et al. for the advantage of using the cover 2 and the cooperating rim 9 together to press the paper down allowing a user to tear of a portion of the dispensed paper.

***Allowable Subject Matter***

15. Claim 12 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Response to Arguments***

16. Applicant's arguments with respect to the Beery reference have been considered but are moot in view of the new ground(s) of rejection.

With respect to applicant's arguments regarding the Takayama reference (US 6,520,395), it is noted that the examiner made reference to the incorrect document number. Takayama is actually US Patent No. 6,520,395. Takayama does indeed provide teaching of a window for viewing inside the tote and confirming the amount of material left inside (Takayama, col. 9, lines 28-30).

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17. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Joyce is cited to show another example of a tote with foldable handles. Warp is cited to show another example of a consumer tote with a flap and core access openings.

18. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel J. Colilla whose telephone number is 571-272-2157. The examiner can normally be reached on M-F 7:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Hirshfeld can be reached on 571-272-2168. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

July 27, 2005



Daniel J. Colilla  
Primary Examiner  
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